

ROCKEY, DEPKE, LYONS & KITZINGER, LLC

Sears Tower
Suite 5450
233 S. Wacker Drive
Chicago, IL 60606-6306
Phone: (312) 277-2006
Fax: (312) 441-0570

RECEIVED
CENTRAL FAX CENTER

NOV 20 2006

Of Counsel
Lewis T. Steadman

FACSIMILE TRANSMISSIONTOTAL PAGES (Including Cover Page) 10 DATE: 11/20/06

Commissioner of Patents and Trademarks

TO: Examiner: Thjuan P. Knowlin FROM: Robert J. Depke, Reg. No. 37,607FAX NO: (571) 273-8300 FAX NO: (312) 704-8137*If you experience any difficulty with this transmission, please call (312) 277-2006 for assistance.***ORIGINAL COPY AND ENCLOSURES**

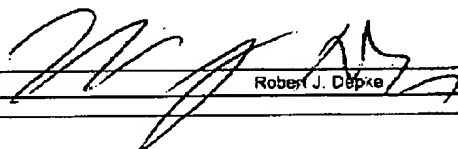
___ WILL BE SENT BY ___ MAIL ___ COURIER
☒ WILL NOT BE SENT

NOTES:

Inventor: Junichi Toyoda et al.
Serial No.: 09/876,411
Art Unit: 2642
Filed: June 7, 2001
Attorney Ref.: 075834.00086

CERTIFICATION OF FACSIMILE TRANSMISSION

I hereby certify that this paper is being facsimile transmitted to the Patent and Trademark Office to facsimile no. 1-571-273-8300 on 11/20/06


Robert J. Depke

IMPORTANT NOTICE

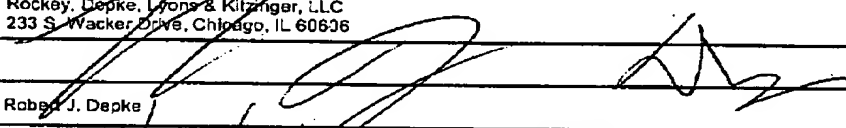
This transmission (including all attached pages) is intended only for the use of the named addressee(s), and may contain information that is privileged or exempt from disclosure under applicable law. **IF YOU ARE NOT A NAMED ADDRESSEE, YOU ARE HEREBY NOTIFIED THAT ANY USE, DISSEMINATION, DISTRIBUTION OR COPYING OF THIS TRANSMISSION IS STRICTLY PROHIBITED.** If you have received this transmission in error, please destroy all copies and notify us immediately at this telephone number: (312) 277-2006.

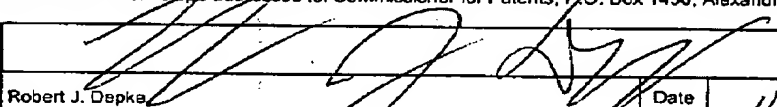
PTO/SB/21 (09-04)
Approved for use through 07/31/2005. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

TRANSMITTAL FORM <i>(to be used for all correspondence after initial filing)</i>	Application Number	09/876,411
	Filing Date	June 7, 2001
	First Named Inventor	Junichi Toyoda et al.
	Art Unit	2842
	Examiner Name	Thjuan P. Knowlin
Total Number of Pages in This Submission	Attorney Docket Number	075834.00086

**RECEIVED
CENTRAL FAX CENTER
NOV 20 2006**

ENCLOSURES (Check all that apply)		
<input checked="" type="checkbox"/> Fee Transmittal Form <input checked="" type="checkbox"/> Fee Attached <input checked="" type="checkbox"/> Amendment/Reply <input checked="" type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Reply to Missing Parts/ Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD. Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance Communication to TC <input checked="" type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input checked="" type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): Pre-Appeal Brief for Review Accompanying Notice of Appeal, Notice of Appeal (PTO/SB/31), Form PTO/SB/33
Remarks The Commissioner is hereby authorized to charge any fees due or to credit any overpayment to Deposit Account No. 50-3891		
SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT		
Firm Name	Rockey, Depke, Lyons & Kitzinger, LLC 233 S. Wacker Drive, Chicago, IL 60606	
Signature		
Printed name	Robert J. Depke	
Date	11/20/06	Reg. No. 37,607

CERTIFICATE OF TRANSMISSION/MAILING		
I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below:		
Signature		
Typed or printed name	Robert J. Depke	Date 11/20/06

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

PTO/SB/17 (10-04)

Approved for use through 07/31/2006. OMB 0651-0032
U.S. Patent and Trademark Office, U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

FEE TRANSMITTAL
for FY 2005

Effective 10/01/2004. Patent fees are subject to annual revision.

☐ Applicant claims small entity status. See 37 CFR 1.27**TOTAL AMOUNT OF PAYMENT** (\$500.00)

Complete if Known

RECEIVED

Application Number	09/876,411	CENTRAL FAX CENTER
Filing Date	June 7, 2001	
First Named Inventor	Junichi Toyoda et al.	NOV 20 2006
Examiner Name	Thjuan P. Knowlin	
Art Unit	2642	
Attorney Docket No.	075834.00036	

METHOD OF PAYMENT (check all that apply)☐ Check ☐ Credit card ☐ Money Order ☐ Other ☐ None☒ Deposit Account:

Deposit Account Number	503891
Deposit Account Name	Rockey, Depke, Lyons et al.

The Director is authorized to: (check all that apply)

☒ Charge fee(s) indicated below ☒ Credit any overpayments☒ Charge any additional fee(s) or any underpayment of fee(s)☐ Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.**FEE CALCULATION****1. BASIC FILING FEE**

Large Entity Fee Code (\$)	Small Entity Fee Code (\$)	Fee Description	Fee Paid
1001 790	2001 395	Utility filing fee	
1002 350	2002 175	Design filing fee	
1003 550	2003 275	Plant filing fee	
1004 790	2004 395	Reissue filing fee	
1005 160	2005 80	Provisional filing fee	
SUBTOTAL (1)			(\$) 0.00

2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

Total Claims	Extra Claims	Fee from below	Fee Paid
Independent Claims	-20** =	X	
Multiple Dependent	-3** =	X	

Large Entity Fee Code (\$)	Small Entity Fee Code (\$)	Fee Description
1202 16	2202 9	Claims in excess of 20
1201 88	2201 44	Independent claims in excess of 3
1203 300	2203 150	Multiple dependent claim, if not paid
1204 88	2204 44	** Reissue independent claims over original patent
1205 18	2205 9	** Reissue claims in excess of 20 and over original patent

SUBTOTAL (2) (\$0.00)

**or number previously paid, if greater. For Reissues, see above

FEE CALCULATION (continued)**3. ADDITIONAL FEES**

Large Entity Fee Code (\$)	Small Entity Fee Code (\$)	Fee Description	Fee Paid
1051 130	2051 65	Surcharge - late filing fee or oath	
1052 50	2052 25	Surcharge - late provisional filing fee or cover sheet	
1053 130	1253 130	Non-English specification	
1812 2,520	1812 2,520	For filing a request for ex parte reexamination	
1804 920*	1804 920*	Requesting publication of SIR prior to Examiner action	
1805 1,840*	1805 1,840*	Requesting publication of SIR after Examiner action	
1251 110	2251 55	Extension for reply within first month	
1252 430	2252 215	Extension for reply within second month	
1253 980	2253 490	Extension for reply within third month	
1254 1,530	2254 765	Extension for reply within fourth month	
1255 2,080	2255 1,040	Extension for reply within fifth month	
1401 340	2401 170	Notice of Appeal	
1402 340	2402 170	Filing a brief in support of an appeal	
1403 300	2403 150	Request for oral hearing	
1451 1,510	1451 1,510	Petition to institute a public use proceeding	
1452 110	2452 55	Petition to revive - unavoidable	
1453 1,330	2453 665	Petition to revive - unintentional	
1501 1,370	2501 685	Utility issue fee (or reissue)	
1502 490	2502 245	Design issue fee	
1503 660	2503 330	Plant issue fee	
1480 130	1480 130	Petitions to the Commissioner	
1807 50	1807 50	Processing fee under 37 CFR 1.17(q)	
1806 160	1806 160	Submission of Information Disclosure Stmt	
8021 40	8021 40	Recording each patent assignment per property (times number of properties)	
1809 790	2809 395	Filing a submission after final rejection (37 CFR 1.129(a))	
1810 790	2810 395	For each additional invention to be examined (37 CFR 1.129(b))	
1801 790	2801 395	Request for Continued Examination (RCE)	
1802 900	1802 900	Request for expedited examination of a design application	

Other fee (specify)

*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$500.00)**SUBMITTED BY**

Name (Print/Type) Robert J. Depke

Signature

Registration No. (Attorney/Agent)

37,607

(Complete if applicable)

Telephone 312-277-2006

Date

11/20/06

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

This collection of information is required by 37 CFR 1.17 and 1.27. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

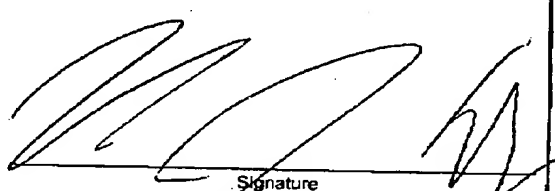
RECEIVED
CENTRAL FAX CENTER

NOV 20 2006

Doc Code: AP.PRE.REQ

PTO/SB/33 (07-35)

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 075834.00086	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" (37 CFR 1.8(a)) on _____ Signature _____ Typed or printed name <u>Robert J. Depke</u>		Application Number 09/876,411	Filed June 7, 2001
		First Named Inventor Junichi Toyoda et al.	
		Art Unit 2642	Examiner Thjuan P. Knowlin
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.			
This request is being filed with a notice of appeal.			
The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/95) <input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>37,607</u> <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____		 Signature Robert J. Depke Typed or printed name 312-277-2006 Telephone number <u>11/20/06</u> Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.			
<input type="checkbox"/> *Total of _____ forms are submitted.			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

NOV 20 2006

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No.: 09/876,411

Confirmation No.: 7306

Applicant: Junichi Toyoda

Filed: June 07, 2001

TC/A.U.: 2614

Examiner: Thjuan P. Knowlin

Docket No.: 075834.00086

Customer No.: 33448

**PRE-APPEAL BRIEF REQUEST FOR REVIEW ACCOMPANYING
NOTICE OF APPEAL**

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

S I R:

ERRORS IN THE PRIOR REJECTION

Consistent with the Review Requirements for identification of clear errors, Applicants note the following:

- I. The prior art references of *Kotsuka* (U.S. Patent No. 6,057,796) and *Paulick* (U.S. Patent No. 5,710,987) fail to teach or suggest the subject matter contained in claims 1 - 18.

REMARKS**A. The §103 Rejection of Claims 1 - 18 Is Improper**

Applicants respectfully request review of the Examiner's rejection of claims 1 - 18 under 35 U.S.C. §103(a). Examiner has rejected these claims in view of the cited prior art references of *Kotsuka* (U.S. Patent No. 6,057,796) and *Paulick* (U.S. Patent No. 5,710,987). The *Kotsuka* reference is directed to an electromagnetic wave absorber which is suitable for a housing of a portable electronic apparatus. (See Column 1, lines 28 - 36). The *Paulick* reference is directed to integrating both a radiotelephone and a pager into a single portable unit (Column 1, lines 24 -

Appl. No. 11/001,951
Pre-Appeal Request for Review Dated October 31, 2006
Reply to Office Action of July 12, 2006

28). As apparently recognized by the Examiner (in light of his withdrawal of this reference as a primary reference), *Paulick* fails to teach or suggest the use of an electro-magnetic wave absorbing element in order to reduce the amount of electromagnetic radiation that reaches the user. Accordingly, Applicants will focus on the application of the *Kotsuka* reference in light of the currently claimed invention.

Applicants submit that the Examiner's rejection of claims 1 – 18 is insufficient for a plurality of reasons. Regarding independent claim 1, Applicants submit that the *Kotsuka* reference fails to teach or suggest “an electro-magnetic wave absorber 31 with one surface (right side of 31 in Fig. 3) adjacent a predetermined area of the conductive case 4A” and “a conductive member 32 provided at another surface (the left side of 31 in Fig. 3) of the electromagnetic wave absorber 31 and being electrically connected to the conductive case (via, for example, the wire 33 in Fig. 3 or the plate 34 in Fig. 5).” The Examiner, in his/her rejection on page 2 of the Office Action, identifies the conductive plate 19 as the “conductive member.” The claim clearly requires two different surfaces of the electromagnetic wave absorber, wherein one surface faces and/or is adjacent to the conductive case, and the other is attached to a conductive member which itself is also electrically connected to the conductive case. The *Kotsuka* reference fails to teach or suggest this limitation. Rather, it only discloses one surface which is adjacent to and/or faces the conductive case 19 (As disclosed in Column 3, lines 2 – 5, the conductive plate 19 clearly makes up the rear of the conductive case 15/19). For at least this reason, Applicants respectfully request that the Examiner withdraw the rejection of claim 1, and place this claim in condition for allowance.

page 2 of 5

Appl. No. 11/001,951

Pre-Appeal Request for Review Dated October 31, 2006

Reply to Office Action of July 12, 2006

Further regarding claims 2, 5, and 6, the Examiner has failed to identify any single prior art reference or combination of reference which teach the placement of the electro-magnetic wave absorber between the conductive case and a head of a user of the communication apparatus. Rather, Kotsuka clearly teaches that the electro-magnetic wave absorber should be used to coat an inside surface of the case, thereby failing to anticipate the plain language of the claim. (See Fig. 1 and Column 4, lines 46 – 49). For at least this reason, Applicants respectfully request that the Examiner withdraw the rejection of claims 2, 5, and 6 and place these claims in condition for allowance.

Further regarding claim 3, Applicants note that the 5th paragraph clearly requires that the electro-magnetic wave absorber have one surface in contact with the shield case, and that a conductive member be provided on another surface of the electric wave absorber and being electrically connected to the case. As noted above with respect to claim 1, Kotsuka fails to teach or suggest such a structure. More specifically, Kotsuka fails to teach or suggest the placement of a conductive member on a surface of the wave-absorbing member different from the surface which is attached to the shield case and connected to the shield case. Fig. 6B of Kotsuka shows one portion of the claim, but fails to teach or suggest the further electrical connection of the matrix 29 to the shield case 19/15. For at least this reason, Applicants respectfully request that the Examiner withdraw the rejection of claim 3 and place this claim in condition for allowance.

Further regarding claims 7, 9, 17, and 18, these claims more clearly specify that the conductive layer includes a metal film formed on a surface of the wave absorber opposite the surface of the wave absorber in contact with the shield case. (See Figure 3, wherein the metal conductor 32 is formed on a surface of the wave absorber 31 opposite the surface connected to
page 3 of 5

Appl. No. 11/001,951

Pre-Appeal Request for Review Dated October 31, 2006

Reply to Office Action of July 12, 2006

the shield case 4A). The Examiner has failed to specifically state in his/her Office Action where this limitation is found in the cited reference. While the embodiment shown in Fig. 6B shows a conductive material 29, it fails to teach or suggest wherein this material is electrically connected back to the shield case to which the wave absorber is attached, as required by the claims and as shown in Figure 3 of Applicant's disclosure (See the wiring 33 which connects the conductor plate 32 back to the shield case 4A). For at least this reason, Applicants respectfully request that the Examiner withdraw the rejection of claims 7, 9, 17, and 18 and place these claims in condition for allowance.

Further regarding claim 8, and as just discussed in the prior paragraph, the cited references of record fail to teach or suggest the claimed metal wiring. For at least this reason, Applicants respectfully request that the Examiner withdraw the rejection of claim 8 and place this claim in condition for allowance.

Further regarding claims 12 and 16, the cited art of record fails to teach or suggest anything regarding the placement of the electro-magnetic wave absorber in relation to the switching circuit, the receiver, and the feeder. For at least this reason, Applicants respectfully request that the Examiner withdraw the rejection of claim 12 and place this claim in condition for allowance.

Further regarding claims 13 and 14, the cited art of record fails to teach or suggest anything regarding the electrical connection of the conductive layer formed on a surface of the wave-absorbing layer to a ground level layer of the printed circuit board, or the electrical connection of the shield case to a ground level layer of the printed circuit board. For at least

Appl. No. 11/001,951
Pre-Appeal Request for Review Dated October 31, 2006
Reply to Office Action of July 12, 2006

these reasons, Applicants respectfully request that the Examiner withdraw the rejection of claims 13 and 14 and place these claims in condition for allowance.

Further regarding claim 15, the cited art of record fails to teach or suggest the use of an outer housing made of an insulating material which encloses the electro-magnetic wave-absorber. Rather, Fig. 1A and the supporting text clearly teach the use of a conductive outer housing 15. For at least this reason, Applicants respectfully request that the Examiner withdraw the rejection of claim 15 and place this claim in condition for allowance.

Respectfully submitted,

Date:

11/20/06

Robert J. Depke

**ROCKEY, DEPKE, LYONS &
KITZINGER, LLC**

Sears Tower, Suite 5450

Chicago, Illinois 60606-6306

Tel: (312) 277-2006

Attorneys for Applicant

(Reg. #37,607)